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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,545	07/24/2003	Yasushi Ogihara	059994-5001	8198
9629	7590	03/06/2006	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			AMARI, ALESSANDRO V	
		ART UNIT	PAPER NUMBER	
			2872	

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/625,545	OGIHARA, YASUSHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alessandro V. Amari	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 November 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.  
 4a) Of the above claim(s) 5-7 and 9-13 is/are withdrawn from consideration.  
 5) Claim(s) 2-4,8 and 15 is/are allowed.  
 6) Claim(s) 1 and 14 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 1 is objected to because of the following informalities:

In regard to claim 1, line 15, the phrase, "a focused position of a first observation point" is confusing and ambiguous since it is uncertain whether this "a focused position" is the same as the "a focused position" recited in line 7 of the claim or whether it is another "focused position". It should be noted that the same amended recitation is included in claim 14, line 10 but that language recites "the focused position of a first observation point" versus "a focused position of a first observation point" in the limitation on line 15 of claim 1.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Price US 5,932,872.

In regard to claim 1, Price teaches (see Figure 1, 4, 5) a microscope system comprising a stage (103) on which a specimen (114) is placed; an image forming optical system (see objective in Fig. 1) that forms an image of the specimen placed on the stage; an image-capturing device (108) that captures the image of the specimen formed

by the image forming optical system; a focused position detection device (106, 112, 113) that detects focused position for the specimen based upon the specimen image captured by the image-capturing device; and a focused position storage device (a part of element 112) that stores in memory the focused position detected by the focused position detection device as described in column 9, lines 43-45, wherein the focused position detection device sets a search range centered around the focused position stored in memory at the focused position storage device and detects the focused position anew by causing the stage and the image forming optical system to move relative to each other over the search range thus set each time a focusing operation is executed wherein a focused position of a first observation point stored in the focused position storage device is shifted from the first observation point to a second observation point, the focused position detection device sets a search range for the second observation point based on the stored focused position of the first observation point as shown in Figures 4 and 5 and as described in column 8, lines 8-67 and column 9, lines 1-67 and column 10, lines 1-36 as currently understood by the current claim language.

In regard to claim 14, Price teaches (see Figure 1, 4, 5) an autofocus control method adopted comprising capturing an image of a specimen (114) placed on a slide glass as described in column 7, lines 13-36, mounted on a stage (103); detecting a focused position (via 106, 112, 113) for the specimen relative to an objective lens (see objective in Fig. 1) by using the captured image of the specimen; storing the focused position into memory at a storage device as described in column 9, lines 43-45;

detecting the focused position anew by moving the stage and the objective lens relative to each other within a search range centered around the focused position stored in the storage device when an instruction for a focusing operation start is issued wherein a focused position of a first observation point stored in the focused position storage device is shifted from the first observation point to a second observation point, the focused position detection device sets a search range for the second observation point based on the stored focused position of the first observation point as shown in Figures 4 and 5 and as described in column 8, lines 8-67 and column 9, lines 1-67 and column 10, lines 1-36 as currently understood by the current claim language.

***Allowable Subject Matter***

4. Claims 2-4, 8 and 15 are allowed.
5. Claims 2-4, 8 and 15 are allowable over the prior art for the reasons cited in the previous office action.

***Response to Arguments***

6. Applicant's arguments filed 9 November 2005 have been fully considered but they are not persuasive.

The Applicant argues that newly amended claims 1 and 14 which recite the feature of "a focused position of a first observation point stored in the focused position storage device is shifted from the first observation point to a second observation point, the focused position detection device sets a search range for the second observation point based on the stored focused position of the first observation point" are not disclosed or taught by the prior art Price which only teaches a binary search autofocus

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carried out by defining two focus positions between which focus is thought to exist and sequentially dividing the range in half to narrow down to the best focus.

In response to this argument, the Examiner would first like to point out that the claim language in claim 1 regarding the “focused position” of the first observation point renders the claim somewhat ambiguous in regards to the scope especially when compared to the other independent claim 14 which recites similar limitations (see objection above). Secondly, it seems that *Price* can at the very least suggest shifting the focus position to different observation points since *Price* describes a process involving movement of the stage 103 or adjusting the objective 107 (see column 8, lines 15-19 and 48-51 of *Price*) in other words, shifting the observation point to a second observation point. Based upon the flow chart in Figure 5, it is apparent that the autofocus mechanism would then set a new search range based upon the stored focus position of the first observation point as shown in steps 254, 256 and 258 as recited in claims 1 and 14.

Therefore, the Examiner maintains the 102 rejections in regard to claims 1 and 14.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alessandro V. Amari whose telephone number is (571) 272-2306. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

avaAvy  
28 February 2006

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